

REMARKS

This paper responds to an Office Action dated July 18, 2003, which was a non-final action.

Claim Rejections Under 35 USC §§102(e)/103

The Office Action rejected claims 1-6 and 10-14 under 35 USC § 103(a) as unpatentable over U.S. Patent 6,381,256 (Stamm) in view of a Centronic document. The Office Action also rejected claims 7-9 and 15 under 35 USC § 103(a) as unpatentable over the Stamm patent in view of the Centronic document and further in view of U.S. Patent 6,463,084 (Govorkov).

In amendments filed November 26, 2002 and May 27, 2003, Applicant argued that the Stamm patent is not a proper §102(e)/103 reference because the present application and the Stamm patent are commonly owned, and thus §103(c) applies.

The July 18, 2003 Office Action found applicant's arguments concerning §103(c) to be "not persuasive," apparently taking the position that the only way to overcome the Stamm patent is to file an oath or declaration under 37 CFR 1.130 to show that the application and the Stamm patent are currently owned by the same party and to show that the inventor of the application is the inventor of the Stamm patent, and to file a terminal disclaimer. [7/18/03 office action, p. 8] However, earlier in the Office Action, it was admitted that "The applied reference has a common assignee with the instant application." [7/18/03 office action, p. 2] Adding to the confusion, the Office Action stated yet another way to overcome the Stamm reference -- for applications filed on or after November 29, 1999, by showing that the subject matter of the reference and the claimed invention were owned by or subject to an obligation of assignment to the same person. [7/18/03 office action, p. 3]

This paper reiterates Applicant's argument that §103(c) removes the Stamm patent as a reference. This paper also argues that §103(c) removes the Govorkov patent as a reference. Both the Stamm and Govorkov patents are assigned to Lambda-Physik AG of Goettingen, Germany. The present application is also assigned to Lambda-Physik AG of Goettingen, Germany.

The statute, 35 USC § 103(c), provides:

- (c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall

not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicant's November 26, 2002 and May 27, 2003 amendments established that the Stamm patent and the present application are commonly owned. The Office Action admits this fact, but, nevertheless, refuses to follow §103(c).

The filing date of the present application is after November 29, 1999, the effective date of an amendment to §103(c). The present application was filed on February 24, 2000. MPEP § 706.02(l)(1) provides:

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution application filed under 37 CFR 1.53(d), and reissues. [Emphasis added].

Since the present application was filed after November 29, 1999, §103(c) removes as prior art any §102(e) references, including Stamm and Govorkov, that are owned by Lambda-Physik AG.

In a telephone interview with the Examiner on October 16, 2003, the undersigned attorney argued that §103(c) prohibits the rejections based on any patent that is owned by Lambda-Physik AG. The Examiner apparently agreed and asked for this response to be filed so that the Examiner could discuss the issue with her supervisory primary examiner.

Summary

The basic facts are these: (1) The filing date of the present application is February 24, 2000, which is after the November 29, 1999 effective date of amended §103. (2) The present application and the Stamm and Govorkov patents are commonly owned.

The conclusion of law that must follow from these facts is that 35 USC §103(c) prohibits the use of the Stamm and Govorkov patents in a rejection under 35 USC §103(a). The rejections are erroneous and must be withdrawn.


Conclusion

For all the reasons set forth above, Applicant requests reconsideration and withdrawal of the rejections stated in the July 18, 2003 Office Action.

Respectfully submitted,

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